

UTILITY PATENT

cket No. P-US-TN1444

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Roger Q. SMITH

Serial No.: 09/153,621 ✓

Examiner: T. Dinh

Filed: September 15, 1998

Group Art Unit: 2841


For: **HEAVY-DUTY AUDIO EQUIPMENT**

Assistant Commissioner for Patents
Washington, DC 20231

AMENDMENT

I, Adan Ayala, Reg. No. 38,373, certify that this
correspondence is being facsimile transmitted to the
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on 12-6-2001


Adan Ayala

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TECHNOLOGY CENTER

Dear Sir:

In response to the Office Action mailed October 12, 2001, please amend the above-
identified application, as follows:

IN THE CLAIMS:

Please amend Claim 1 in accordance with the following rewritten claim in clean
form. Applicant includes herewith an Attachment for Claim Amendments showing a
marked up version of amended Claim 1.

1. (Amended) An audio equipment comprising:

a housing;

B' an audio circuitry installed within the housing; and

a first protective bar flexibly connected to the housing.

REMARKS

Applicant would like to extend his sincere thanks to the Examiner for conducting a telephone interview to discuss the Office Action. The following response will address the issues raised in the final Office Action mailed July 31, 2001, as well as during the interview.

Applicant has amended Claim 1. Currently in the application are Claims 1-6 and 15-20.

The Examiner has objected to Claim 1 and requested that the word ~~an~~ be inserted before "audio circuitry". In response, Applicant has amended Claim 1 accordingly.

The Examiner has rejected Claims 1-6 under 35 USC § 103(a) as being unpatentable over US Patent No. 2,058,407 ("Brown") in view of US Patent No. 5,669,323 ("Pritchard"). This rejection is respectfully traversed.

Claim 1 calls for an audio equipment comprising a housing, an audio circuitry installed within the housing, and a first protective bar flexibly connected to the housing.

Admittedly, Brown discloses a housing containing audio circuitry, and that the housing is connected to a leg assembly 14,15. However, this leg assembly is neither the protective bars called for in Claim 1, nor flexibly connected to the housing. The Examiner relies on Pritchard to provide the flexible connection assembly.

The Examiner cannot combine Brown with Pritchard for three reasons. First, Pritchard is not analogous art. Second, no motivation or suggestion to combine Brown with Pritchard exists. Third, even if combined, the Brown/Pritchard device would not have all claimed elements.

Pritchard is not analogous art because a person of ordinary skill in the radio arts would not look in the canoe bailing field for a solution. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of

applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) (*quoted by* MPEP § 2141.01(a), at 2100-115 (Aug. 2001, 8th ed.)).

Oetiker provides a good example of what can be considered analogous prior art in the mechanical arts, which include the present invention. In *Oetiker*, the applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The CAFC held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.

Similarly, the Examiner has provided no evidence that a person of ordinary skill, seeking to solve a problem of protecting a radio, would reasonably be expected or motivated to look for flexible connections in automatic bailers for canoes. When asked why a person of ordinary skill in the art would look there, the Examiner mentioned that the person of ordinary skill would look for any flexible connections anywhere, including the canoe bailing field. When Applicant's attorney explained that such analysis was prohibited by *Oetiker*, the Examiner counter-argued that "common sense knowledge" would lead the person of ordinary skill to look in the canoe bailing field.

Applicant disagrees. Just like the PTO was not allowed to bring in hooks from the garment fastening field into the hose clamp fastening field, the Examiner should not be allowed to bring in flexible connections from the canoe bailing field into the radio field, especially where the Examiner has not provided any evidence that a person of ordinary skill would look in the canoe bailing field. Applicant hereby requests that the Examiner provide any evidence so that Applicant can fully prepare his argument in the event of an appeal to the Board is necessary.

Even if Pritchard is analogous art, the Examiner has failed to establish a prima facie case that it should be combined with Brown. According to MPEP § 2142, to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2142, at 2100-121. Second, the prior art references must teach or suggest all the claim limitations. *Id.*

In the present case, no suggestion to combine or modify Brown with Pritchard exists because such modification would render Brown unsatisfactory for its intended purpose. "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01, at 2100-124 (*citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

In his Office Action, the Examiner proposed to add Pritchard's flexible connection assembly 28 to the Brown device. When asked to clarify such combination during the telephone interview, the Examiner noted that the flexible connection assembly 28 would replace Brown's pivotable connection 16. Such modification would render

Brown, the prior art invention being modified, unsatisfactory for its intended purpose, i.e., maintaining the radio cabinet in a desired tilted position. (See Brown, col. 2, lns. 38-51.)

According to Brown, a pivotal connection is provided between the leg members and the cabinet. This pivotal connection includes block 16 connecting the leg members 14,15 and a circular disk 19 provided on the cabinet, which "is positioned in the recess of the respective block 16." Brown, col. 2, lns. 26-30 and 38-41. The disk 19 is in frictional contact with the block 16 so that the cabinet can "remain in any of its usual tilted positions." Brown, col. 2, lns. 43-51. In other words, if the user tilts the radio cabinet to a desired position, the pivotal connection will maintain the cabinet at the desired pivotal position.

According to Pritchard, the flexible connection assembly 28 includes a flexible sleeve 100, which is "made of rubber tubing or of a similar resilient material." Pritchard, col. 5, lns. 42-44. According to the Merriam-Webster's Collegiate Dictionary (online edition; see attached print-outs), "resilient" is defined as "characterized or marked by resilience." "Resilience" in turn is defined as "the capability of a strained body to recover its size and shape after deformation." Accordingly, a resilient material, such as rubber tubing, would be a material capable of recovering its size and shape after deformation.

If Pritchard's flexible connection assembly 28 replaces Brown's pivotal connection, the combined device will have a resilient connection. In other words, if the user tilts the radio cabinet to a desired position, the resilient connection will not maintain the cabinet at the desired pivotal position. Instead, the radio cabinet would return to the untilted position. Accordingly, Brown, the prior art invention being modified, would be rendered unsatisfactory for its intended purpose, i.e., maintaining the radio cabinet in a

desired tilted position. Therefore, no suggestion to modify or combine Brown with Pritchard can exist.

Furthermore, no suggestion to combine or modify Brown with Pritchard exists because the modification would change the principle of operation of Brown. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." MPEP § 2143.01, at 2100-125 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

As explained above, Brown discloses a pivotal connection relying on friction to maintain the radio cabinet in the desired tilted position. The Examiner proposed replacing such pivotal connection with Pritchard's resilient connection, which would not maintain the radio cabinet in the desired tilted position. This in effect is changing the principle of operation of Brown, the prior art invention being modified. Thus, "the teachings of the references are not sufficient to render the claims prima facie obvious" under MPEP § 2143.01.

During the interview, the Examiner posed three counter-arguments as to the MPEP-based arguments above. First, Claim 1 does not call for a resilient connection. Second, the test for obviousness is not whether a structure in a reference can be bodily substituted into another reference. Third, the flexible connection of Pritchard is not resilient and can maintain the Brown radio cabinet in the tilted position. Applicant will address each counter-argument individually.

As to the first counter-argument, the Examiner is correct that Claim 1 does not require a resilient connection. Claim 1 calls for the protective bar to be flexibly connected to the housing. This flexible connection is preferably resilient, but it need not

be. Nevertheless, the Examiner misses the point. Applicant's point is not that Claim 1 calls for a resilient connection. Applicant's point is that substituting Brown's friction-based pivotal connection for Pritchard's flexible connection would (a) render Brown unsuitable for its intended purpose and (b) change Brown's principle of operation. Under the legal precedent cited above, no motivation exists to combine Brown with Pritchard, and thus the Examiner cannot use Brown and Pritchard to render the claims unpatentable, regardless what the claims call for. Thus, the Examiner's first counter-argument is inapplicable.

As to the second counter-argument, the Examiner is correct in stating that the proper test of obviousness is not whether a structure in a reference can be bodily substituted into another reference. Once again, the Examiner misses the point. Applicant does not question that Pritchard's resilient connection can be bodily substituted into Brown. Instead, Applicant argues that Brown and Pritchard cannot be legally combined to render the claims unpatentable as the Examiner has failed to meet the prima facie requirement. Thus, the Examiner's second counter-argument is inapplicable.

As to the Examiner's third counter-argument, the Examiner is incorrect in stating that the flexible connection of Pritchard is not resilient and can maintain the Brown radio cabinet in the tilted position. Again, Applicant refers the Examiner to col. 5, lns. 41-43, where the flexible sleeve 100 is described as being "made of rubber tubing or of a similar resilient material." In other words, Pritchard explicitly teaches a resilient connection.

When asked to provide any proof as to how Pritchard taught a non-resilient connection, the Examiner was not able to support his position with Pritchard.¹

¹ Applicant hereby requests that Examiner provide all proof showing that Pritchard teaches a non-resilient connection, so that Applicant can prepare his argument in the event an appeal to the Board is necessary.

Accordingly, until the Examiner provides further proof otherwise, Pritchard must be read as teaching a resilient connection. Because of this, combining Pritchard with Brown would (a) render Brown unsuitable for its intended purpose and (b) change Brown's principle of operation. Under the legal precedent cited above, no motivation exists to combine Brown with Pritchard, and thus the Examiner cannot use Brown and Pritchard to render the claims unpatentable.

Finally, even if Brown and Pritchard are combined, the combination does not teach all the claimed elements. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *Id.* (quoting *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970)) (emphasis added). In the present case, the Examiner has failed to show that the leg assembly is "protective."

As discussed in the specification, the protective bar is provided to protect the housing from being destroyed at a jobsite because of: (1) tools being dropped on the housing; or (2) the radio falling down. In Brown, however, the leg assembly does not serve to protect the radio. For example, Applicant notes that FIG. 5 of Brown shows no protection for the housing surrounding speaker 6a against any side blows.

Accordingly, the leg assembly only serves to support the radio in place. Therefore, the leg assembly is not a "protective" bar as called for in Claim 1. Pritchard does not supplement such missing element either. Thus, the Brown/Pritchard combination cannot render Claim 1 and its dependent claims unpatentable.

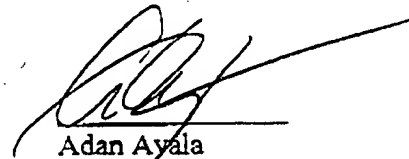
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In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 1-6 and 15-20 are respectfully requested.

No fee is due for the present amendment. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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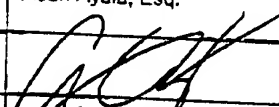
TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/153,621
	Filing Date	September 15, 1998
	First Named Inventor	Roger Q. Smith
	Group Art Unit	2841
	Examiner Name	T. Dinh
Total Number of Pages In This Submission	Attorney Docket Number	P-US-TN1444

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